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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/551,299	04/18/2000	Andrew Frank	003574.P003	1950

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EXAMINER

DANG, KHANH NMN

ART UNIT	PAPER NUMBER
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2181

DATE MAILED: 10/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/551,299

Applicant(s)

FRANK, ANDREW

Examiner

Khanh Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: .

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, drawn to apparatus to control power distribution from a UPS, classified in class 713, subclass 300.
 - II. Claims 16-38, drawn to apparatus and method for expanding a computer interface, classified in class 710, subclass 101.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as controlling distribution of power from an uninterruptible power supply. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group I is not required for Group II, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. **During a telephone conversation with Mr. Marvin Beekman on 8/13/2003 a provisional election was made without traverse to prosecute the invention of**

Group II, claims 16-38. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 30, the phrase "the bus control module controls a plurality of switches to control power from the UPS to a plurality of external devices" is unclear and cannot be ascertained. In claim 16, the bus control module provides protocol conversion between buses.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16, 17, 18, 20, 28, 32-34, 36-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Dickens et al.

At the outset, it is noted that similar claims will be grouped together to avoid repetition in explanation.

As broadly drafted, these claims do not define any structure that differs from Dickens et al. With regard to claims 16, 31, it is first noted that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. In any event, Dickens et al. discloses a device (100) for expanding a computer interface, comprising: an upstream connector for connecting to a computer (105) through a serial bus (106) using a serial bus protocol, wherein the device (100) is external to the computer (105); at least one legacy expansion bus structure (132, for example), each legacy expansion bus structure having a legacy bus protocol; and a bus control module (USB host controller 154/156/158, for example) connected to the upstream connector and to the at least one legacy expansion bus structure, wherein the bus control module is adapted to provide a protocol conversion between the serial bus protocol and the legacy bus protocol. With regard to claim 17, the legacy expansion bus structure may be a PCI bus 132. With regard to claim 18, the legacy expansion bus structure may be a ISA bus 160. With regard to claim 20, the legacy bus may be a PCMCIA bus with PCMCIA controller 134. With regard to claim 28, the serial bus includes a Universal Serial Bus (USB). With

regard to claims 32-34, 36, 37, and 38, it is clear that one using the device of Dickens et al. would have performed the same method steps set forth in claims 32-34, 36-38.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickens et al.

Dickens et al., as explained above, discloses the claimed invention including the use of a plurality of legacy buses. However, Dickens et al. does not disclose the use of a EISA bus. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Dickens et al. with a EISA bus, since the Examiner takes Official Notice that EISA bus (an extension of the ISA architecture, which is a standardized version of the bus originally developed by IBM for their PC computers) is notoriously well-known as a legacy bus; and it is clear that providing Dickens et al. with such a bus only involves ordinary skill in the art. If Applicants choose to challenge the fact that EISA bus is old and well-known, supportive document(s) will be provided upon request.

Claims 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickens et al.

Dickens et al., as explained above, discloses the claimed invention including the use of at least one legacy bus structure. However, Dickens et al. does not disclose the use of an expansion slot (claim 21) having an expansion card (claim 22) connected thereto. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Dickens et al. with an expansion slot (PCI slot, for example) having an expansion card (PCI card, for example), since the Examiner takes Official Notice that the use of PCI slot for PCI card comprising serial port (claim 22) or parallel port (claim 23) is notoriously old and well-known in the art; and it is clear that providing Dickens et al. with such PCI slot/card only involves ordinary skill in the art. If Applicants choose to challenge the fact that PCI slot/card is old and well-known, supportive document(s) will be provided upon request. With regard to claims 24-27, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Dickens et al. with a modem connector (claim 24), a network connector (claim 25), DSL port (claim 26), or cable modem (claim 27) connected to at least a legacy bus, since the Examiner takes Official Notice that the use of a modem connector (claim 24), a network connector (claim 25), DSL port (claim 26), or cable modem (claim 27) for connection to the Internet or Networking is notoriously old and well-known in the art; and it is clear that providing Dickens et al. with such a modem connector (claim 24), a network connector (claim 25), DSL port (claim 26), or cable modem (claim 27) for connection to the Internet or Networking only

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involves ordinary skill in the art. If Applicants choose to challenge the fact that a modem connector (claim 24), a network connector (claim 25), DSL port (claim 26), or cable modem (claim 27) is old and well-known for providing connectivity to the Internet or Networking, supportive document(s) will be provided upon request.

Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickens et al.

Dickens et al., as explained above, discloses the claimed invention except the use of an uninterruptible power supply (UPS). However, UPS is well-known for its use in computer and electronic devices to prevent power surge and data loss from power failure. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Dickens et al. with a UPS, since the Examiner takes Official Notice that UPS is notoriously well-known in the art; and it is clear that providing Dickens et al. with such a UPS only involves ordinary skill in the art. If Applicants choose to challenge the fact that UPS is old and well-known, supportive document(s) will be provided upon request. With regard to claim 30 (as best understood), it is clear that the device of Dickens et al. controls electrical/logic switches to continue provide power to a plurality of external devices connected thereto in case of a sudden power failure so that data loss, for example, can be prevented.

U.S. Patent Nos. 5,784,581 to Hannah, 6,324,605 to Rafferty et al., 6,131,125 to Rostoker et al., and 6,625,790 to Casebolt et al. are cited as relevant art.

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Any inquiry concerning this communication should be directed to Khanh Dang at
telephone number 703-308-0211.

Khanh Dang

**Khanh Dang
Primary Examiner**